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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/777,336 12/27/96 HOLMES

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EXAMINER

GELIN, J

ART UNIT

PAPER NUMBER

2744

DATE MAILED:

08/13/99

*14*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/777,336

Applicant

David W.J. Holmes

Examiner  
Jean A. Gelin

Group Art Unit  
2744



☒ Responsive to communication(s) filed on ~~Dec 27, 1996~~ July 8/23, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-16 and 21 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-16 and 21 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. This is in response to the applicant's amendment received on July 26, 199 in which claims 1, 12-14, 21 have been amended, and claims 17-20. Claims 1-16, 21 are currently pending.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 10-14, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Grube et al. (Grube).

Regarding to claim 1, Grube teaches in a communication system comprising a first over the air network and a second over the air network wherein a mobile station is capable of being coupled to either one of the first and second networks, a method for notifying the mobile station of a communication on one of the first and second a networks to which the station is not presently coupled (col. 3, lines 34-39; fig. 1), the method comprising the steps of: storing an address for the mobile station camped on one of said first and second over the air networks (col. 5, lines 20-29); receiving a communication request from that one of said first and second over the air networks to which the mobile station is not presently coupled (col. 5, lines 4-41); using the stored address of the mobile station camped on one of said first and second over the air networks to send an alert

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that said communication request has been received wherein said alert informs the mobile station that said communication request is available on said one of said first and second over the air networks to which the mobile station is not presently coupled (col. 2, lines 29-59; col. 4, lines 20-51).

“With respect to claims 12-13, they have limitations similar to those discussed above, and hence are rejected as being anticipated by Grube et al. for the same reason given above.”

Regarding to claim 2, Grube teaches the steps of: detecting when the mobile station changes it a camp-on status between the first and second over the air networks (col. 3, lines 1-7); and updating a memory with an address of the mobile station in the network on which it is camped (col. 4, lines 47-51).

Regarding to claims 10, 11, Grube further teaches said alert includes information regarding said received communication request, and said information includes how the mobile station should connect to the communication (col. 5, lines 30-56).

Regarding to claim 14, Grube teaches a communication system for permitting communication requests to follow a mobile station that can only be coupled to one network at a time after it changes networks (col. 2, lines 29-54), the system comprising: memory storing an address of a mobile station on a network to which it is coupled (col. 5, lines 23-29); a communication receiver that receives a communications request on a network to which the mobile station is not coupled (col. 4, lines 40-51); and a processor (i.e., microcomputer), coupled to said memory and said communication receiver and using said address of the mobile station to alert the

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mobile station that said communication request was received (col. 4, lines 40-65); and receiving an indication that said mobile station has changed network status to camp on to the network associated with the communication request (col. 4, line 66 to col. 5, line 56).

“With respect to claim 21, it has limitations similar to those discussed above, and hence are rejected as being anticipated by Grube et al. for the same reason given above.”

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-9, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grube et al. in view of Ejzak et al. (Ejzak).

Regarding to claims 3, 4, 8, 9, Grube teaches all the limitations above except said first network is a voice network and said second network is a paging network, and said first network is a voice network and said second network is a data network.

However, voice network and paging network or data network are very well known in the art of communications as evidenced by Ejzak. Ejzak discloses a voice system (i.e., AMPS) and packet data system (i.e., CDPD) that share the RF spectrum. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have implemented the

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teachings of Ejzak within the system of Grube in order to receive voice, Electronic Mail, Paging data (col. 3, line 39 to col. 4, line 35).

Regarding to claims 5, 7, Grube inherently teaches the mobile station is initially camped on to said first network, said step of storing occurs after the mobile station camps on to the second network, and said step of receiving receives a communication request from said first network (col. 4, lines 20-51).

Regarding to claim 6, Grube teaches the step of receiving receives a communication request from said second network (col. 3, lines 20-50).

Regarding to claims 15, 16, Grube teaches all the limitations recited in claim 14, but Grube fails to disclose the mobile station coupled to a wireless voice network and then changes to a data wireless network, said communication request being received by said voice network, and the mobile station is coupled to a data network and then changes to a voice network, said communication request being received by said data network.

However, the mobile station coupled to a wireless voice network and then changes to a data wireless network or the mobile station is coupled to a data network and then changes to a voice network is very well known in the art of communications, as by evidenced Ejzak. Ejzak discloses a combined system which is capable of executing both voice and data communication (col. 4, lines 10-58). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have implemented the teachings of Ejzak within the system of Grube, so that when AMPS (voice) subsequently transmits on a channel in use by the CDPD (packet) the

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cell data must abandon the data connection, identify an idle channel, and complete connections via a newly selected channel (col. 3, line 67 to col. 4, line 3).

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Comroe et al. teaches method for transferring a private call from a trunking communication system to a cellular communication system.

*Conclusion*

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 305-9508 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (703) 305-4847.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

J. Gelin

August 6, 1999

J.G



DWAYNE D. BOST  
SUPERVISORY PATENT EXAMINER  
GROUP 2700